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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,107	09/30/2003	Michael A. Wack	DEP0673USCIP2	4990
27777 7590 04/03/2009 PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003				
EXAMINER RAMANA, ANURADHA				
ART UNIT		PAPER NUMBER		
3775				
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04/03/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/675,107

Applicant(s)

WACK ET AL.

Examiner

Anu Ramana

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-28 and 32-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19, 21, 22, 25-27 and 32 is/are rejected.
- 7) ☒ Claim(s) 20, 23-24, 28 and 33-37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 25, lines 2-3 the recitation "guide fastener drill fastener" renders the claim vague and indefinite because the scope of the claim is unclear.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 19, 22, 26, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Knox (US 6,332,887).

Knox discloses a guide 200 including: a riser (202, 204); a targeting guide (holes in faceplate 226 receiving screws or alignment fasteners 228; and a tube or bushing having an elliptical or non-circular cross section, the bushing received

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between the arms of the riser (Figs. 6A and 10, col. 7, lines 11-35 and lines 66-67, and col. 8, lines 1-19).

Claim 32 is rejected under 35 U.S.C. 102(e) as being anticipated by Aikins et al. (US 2003/0040748 A1).

Aikins et al. disclose a guide including: a body having a riser 170; a first targeting guide 196; and a sheath 202 fittable to the body. Aikins et al. further disclose a compression drill guide 204 slidably fittable within the elongate bore of the sheath; and a noncompression drill guide or tap sleeve slidably fittable within the elongate bore of the sheath (Figs. 18 and 21 and paras [0076]-[0078]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19, 25, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin et al. (US 5,312,409) in view of Knox (US 6,332,887).

McLaughlin discloses a guide including: a body having a riser 2 and a first targeting guide 4; and a tube or first bushing fittable in guide 4 wherein the bushing may be of different shapes and sizes depending on the shape and size of the drill bit being used in the surgical operation (Figs. 1 and 2 and col. 3, lines 15-25).

Regarding claim 25, the examiner is interpreting a second bushing of a different size from the first bushing to be the alignment fastener bushing.

McLaughlin discloses all elements of the claimed invention except for a bushing having an elongated bore with a non-circular cross section.

Knox teaches bushings with non-circular bores for use with specific drill types (Figs. 6A and 10, col. 7, lines 11-35 and lines 66-67, and col. 8, lines 1-19).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made, to have tried a non-circular cross section for a bushing in the McLaughlin device, since there are a finite number of identified, predictable potential solutions, or shapes, as identified by Knox, and one of ordinary skill in the art could have pursued the known options within his or her technical grasp with a reasonable expectation of success.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over McLaughlin et al. (US 5,312,409) in view of Knox (US 6,332,887), further in view of Levy (US 5,540,695).

The combination of McLaughlin et al. and Knox discloses all elements of the claimed invention except for a portion of the guide being made of a radiolucent material.

Levy teaches making a drill guide of a radiolucent material so that fluoroscopy can be utilized to align the drill guide (col. 6, lines 39-46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed a portion of the guide of the combination of McLaughlin et al. and Knox, for example the bushing, of radiolucent material, as taught by Levy, so that fluoroscopy could be used to check alignment of the guide.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knox (US 6,332,887) in view of Levy (US 5,540,695).

Knox discloses all elements of the claimed invention except for a portion of the guide being made of a radiolucent material.

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Levy teaches making a drill guide of a radiolucent material so that fluoroscopy can be utilized to align the drill guide (col. 6, lines 39-46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed a portion of the Knox guide, of radiolucent material, as taught by Levy, so that fluoroscopy could be used to check alignment of the guide.

Response to Arguments

Applicant's arguments filed on March 13, 2009 have been fully considered.

Regarding the rejection of claim 32 over Aikins et al., it is noted that first targeting guide 196 extends laterally from riser 170 in an assembled configuration of the device (see Fig. 18, 20, and 21).

Applicant's arguments with respect to claim 19 are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

Claims 20, 23-24, 28, and 33-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached at (571) 272-4746. The

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fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR

March 30, 2009

/Anu Ramana/

Primary Examiner, Art Unit 3775